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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/508,356	03/09/2000	Martin Greppmair	72.011	9745

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EXAMINER

ADDIE, RAYMOND W

ART UNIT	PAPER NUMBER
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3671

DATE MAILED: 12/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/508,356

Applicant(s)

GREPPMAIR, MARTIN

Examiner

Raymond W. Addie

Art Unit

3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/18/2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 9-15 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 9 includes additional structural features and relationships with respect to a "crank disc connected to a drive shaft"; that was not originally presented.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 9-15 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5, 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linz # 3,756,735 in view of Darda # 3,957,309.

Linz discloses a vibration tamper comprising:

A working mass (5), which is driven in a tamping manner, via a crank mechanism (2, 3, 4, 6, 7, 8) and a spring mechanism (9, 10, 11).

Art Unit: 3671

A motor belonging to an upper mass (1) wherein the crank mechanism has at least one structural element (3, 4, 6) which is movable linearly back and forth. Said structural element (4) comprising a guide piston, element (3) comprises a connecting rod, element 6 comprising a piston guide. See col. 4, lines 11-65.

What Linz does not disclose utilizing materials less dense than steel.

However, Darda teaches a tamping device for breaking up rocks comprising an aluminum guide piston assembly (1), having an aluminum piston guide (18).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to provide the vibration tamper of Linz, with an aluminum piston assembly, in order to reduce the dead weight of the tamper.

3. Claims 3, 4, 7, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linz # 3,756,735 in view of Darda # 3,957,309 as applied to claim 1 above, and further in view of Pauliukonis # 3,703,125.

Linz in view of Darda disclose essentially all that is claimed, except for a plastic piston assembly.

However, Pauliukonis discloses an all plastic piston and cylinder assembly (1, 13, 10), including an integrally molded end closure (12). See Fig. 1; col. 2, lines 45-68. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to provide the vibration tamper of Linz, in view of Darda, with a plastic cylinder assembly, as taught by Pauliukonis, in order to reduce the deadweight of the tamper.

Response to Arguments

4. Applicant's arguments filed 4/18/2003 have been fully considered but they are not persuasive. Applicant argues against the rejection of Claim 1 by stating "an Examiner cannot simply recite different features of the claimed invention from different prior art sources without explaining the motivation to combine or modify the prior art, reference. There must be actual evidence of a suggestion or motivation and the showing must be clear and particular...Broad (sic) conclusionary statements regarding the teaching of multiple references teach away from their combination".

Applicant supports the argument by stating "Darda was clearly of the opinion that aluminum was unstable and that Darda's aluminum tubular element must be with a protective steel ring to improve the mechanical stability of the lower end of the tubular element (18)".

However, Applicant's assertions are supported by any specific disclosure or teaching of secondary reference. Further, the language of the independent claims, is put forth in an open-ended manner, utilizing phrases such as "a crank mechanism and spring assembly... the crank mechanism has at least one structural element... which is produced from a material, the density of which is lower than that of steel".

Hence, the cited claim language can not be seen as to limit the claimed invention to a single element; nor to preclude the crank and spring assembly disclosed by Darda.

Further, in response to Applicant's argument that Darda includes additional structure not required by Applicant's invention, it must be noted that Darda discloses the invention claimed. The fact that the reference teaches additional structure not claimed is irrelevant.

The Applicant then argues "the Examiner is merely defining the problem in terms of its solution...only through improper hindsight reconstruction, that the invention would have been produced.

However, Linz discloses the claimed invention except for "at least one structural element which is moveable...is produced from a material the density of which being lower than that of steel". It would have been obvious to one having ordinary skill in the art, at the time the invention was made, make at least one crank mechanism element from a non-steel material, since it has been held to be within the general skill of a worker in the art, to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In this case, Darda discloses the use of an aluminum guide piston assembly in a rock breaking apparatus, such as a compression hammer; to which the Applicant admits, is analogous art, in page 5 of the Specification. Therefore, the rejection is seen as proper and is upheld.

Art Unit: 3671

Applicant then argues "claim 1 does not require that any structural element can be made from a material lighter than steel...It instead requires that the lighter side must be 'moveable linearly back and forth...In Darda, the structural element that is made form aluminum is a *stationary* tubular element (18).

However, In response to Applicant's argument that the non steel element of Darda is *stationary*, it has been held that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter, but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. In re Bozek, 163 USPQ 545 (CCPA 1969). In this case, the primary reference to Linz discloses a vibration tamper, but does not disclose the material composition of the various moveable and non-moveable crank and spring mechanism elements. Darda teaches it is desirable to make at least one crank mechanism element or spring assembly element from a material lighter than steel, such as aluminum. For elements intended to experience high specific pressures, Darda contemplates the use of hardened steel. Alternatively, Darda further teaches aluminum, in areas not expecting to experience high specific pressures. Hence, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to make at least one structural, moveable element of Linz, from a material less dense than steel, as taught by Darda, in order to minimize the dead weight of the tamping device.

Art Unit: 3671

Applicant argues against the rejection of claims 3, 4 and in particular to the reference to Pauliukonis by stating "although the Pauliukonis '125 patent discloses an all plastic one-piece molded inner housing and a one piece piston and rod assembly comprising of the piston and piston rod, the reference fails to teach 'a piston guide that is produced form plastic in one piece together with at least one dampening bushing".

However, Pauliukonis '125 teaches a plurality of embodiments, the embodiment shown in Fig. 3, intended for use in high to moderate operating pressures comprises "an all-plastic one-piece molded piston rod assembly (18) with integral piston rod (19) and a double-grooved piston (20), as well as an additional embodiment, shown in Fig. 4, comprising: A composite piston rod assembly, having impact-absorbing pegs (8), and rubber piston (24) molded into a one-piece composite assembly.

Hence, Pauliukonis '125 discloses the obviousness in utilizing plastics and rubber materials, in processes for making integrally molded piston assemblies.

Therefore, the arguments are not persuasive and the rejection is upheld.

In regards to Claim 5, Applicant argues "In fact, the combination of references suggested by the examiner teaches away from the tamping machine defined in independent claim 5".

However, the Applicant does not put forth how or in what manner the references teach away from the claimed invention.

• Art Unit: 3671

Therefore, the argument is not persuasive and the rejection is upheld.

In regards to Claim 6, the Applicant argues "Claim 6 depends from Claim 5 and defines a tamping machine not shown or suggested in the prior art".

However, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

In regards to Claims 7 and 8, Applicant argues "none of the cited references show or suggest the material from which at least one structural element is produced to be plastic or that the piston guide be fabricated from plastic in one piece together with at least one dampening bush".

However, as cited previously, Pauliukonis '125 teaches that piston assemblies can be integrally formed using molded plastics or rubber material, to include impact absorbing devices, in various embodiments. Therefore, the argument is not persuasive and the rejection is upheld.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

•Art Unit: 3671

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond Addie whose telephone number is (703) 305-0135. The examiner can normally be reached on Monday-Friday from 7:00 am to 2:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will, can be reached on (703) 308-3870. The fax phone number for this Group is (703) 872-9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.


Thomas B. Will
Supervisory Patent Examiner
Group 3600

RWA
12/16/2003